

Notice of Allowability

Application No.

10/706,426

Examiner

Roberto Rábago

Applicant(s)

TADA ET AL.

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7/18/2007.
2. ☒ The allowed claim(s) is/are 26,28-32,34-39,41-45 and 47-51.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/871,539.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Attachment to Notice of Allowability

Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. The Examiner's amendment to the specification is made to correct an obvious typographical error in the first sentence of the specification.

Authorization for this examiner's amendment was given in a telephone interview with Brian Duncan on 9/25/2007.

In the specification:

On page 1, under CROSS REFERENCE TO RELATED APPLICATION, replace the priority claim sentence with the following:

This application is a division of copending U.S. Application Serial No. ~~091871,539~~ 09/871,539, filed May 31, 2001, now abandoned, the entire contents of which are hereby incorporated herein by reference.

In the amendment to page 26 of the specification, filed 4/13/2006, in the first line of the paragraph beginning at line 19, change "5°C" to -- 5°C --.

In the claims:

In claim 45, delete the eleventh line from the end (beginning with "R⁸ represents ..") through the fifth line from the end ("p represents 1 or 2;"). The lines to be deleted are found on page 16, numbered lines 36-42 of the amendment filed 7/18/2007.

Other Matters

2. The substitute specification filed 4/13/2006 is approved for entry.
Originally filed Figures 2, 5 and 6 are approved by the examiner.
Replacement Figures 1, 3 and 4 filed 8/29/2006 are approved by the examiner.

Allowable Subject Matter

3. The following is an examiner's statement of reasons for allowance. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The complex required in the claims is known in the prior art for use as a dye in combination with various polymers. However, the prior art has not described such compositions including the required purity level of the complex. Sukata et al. (US 5,843,611) discloses compositions of the monoazo complex with various polymers for use as toner and in paint, and teaches that the process of making the complex often results in not only the 2:1 complex as required in the instant claims, but also the 6:4 and

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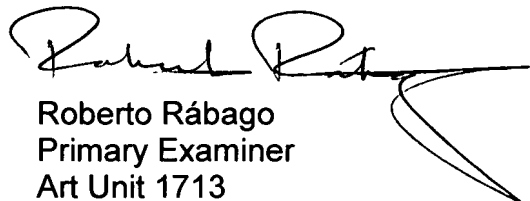
3:2 complexes, as well as unreacted monoazo ligand (see Examples). Compositions comprising these additional mixture components as well as any other impurities are excluded from the claims if their presence exceeds 10% as determined by the stated HPLC method. Ookubo et al. (US 6,120,958) also discloses the required complex for use in toner, and has described a treatment step comprising an aqueous solution of dilute alcohol (see Preparation Example 1); however, this is stated to be an ion-exchange step rather than a purification step, and differs substantially from the purification method disclosed in the instant application. It is noted that in applicants' examples, treatment of the complex in pure alcohol at elevated temperature achieves only 94-96% purity; accordingly, there is insufficient basis to conclude that the method of Ookubo would necessarily achieve the claimed purity. Koshida et al. (US 20060030650) discloses resin compositions comprising the required complex for use in laser welding; however, no information of any kind is given regarding the purity of the complex. In sum, none of the references cited on this record address the issue of purity sufficiently to conclude that the claimed level would be inherent; furthermore, applicants have shown that increasing the purity level substantially decreases the occurrence of skin sensitization in a manner which would not have been expected.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Roberto Rábago
Primary Examiner
Art Unit 1713

RR
September 25, 2007